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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,043

11/26/2003

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7590 11/09/2007  
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EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

11/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/723,043

Applicant(s)

PACETTI, STEPHEN D.

Examiner

Eric E. Silverman, PhD

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40, 43-47 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) 1-27, 30-35, 37-40, 43-47, 49-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28, 29 and 36 is/are rejected.
- 7) ☒ Claim(s) 28, 29 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3-22-06, 4-26-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1615

### DETAILED ACTION

Applicants' response to the Election/Restriction requirement, filed 10/2/2007, has been received. The election of group II, claims 28, 29, and 36 without traverse is noted. Claims 1 – 27, 30 – 35, and 37 – 52 are withdrawn.

The election of the ABA block copolymer of claim 3, namely a poly(styrene-*b*-isobutylene-*b*-styrene) or SIBS copolymer, is acknowledged. The election of the conjugate of claim 7 is also acknowledged.

Pursuant to the election, claims 28, 29, and 36 are discussed on the merits in this action.

### *Claim Objections*

Claims 28, 29, and 36 are objected to for ultimately depending a withdrawn claim 1.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 28, 29 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a written description rejection.**

The claims require a method comprising coating a composition defined in claim 1. Claim 1 defines a polymer composition. The specification teaches that the composition of claim 1 is used to coat a device, but the specification does not teach coating the polymer composition itself. Accordingly, the specification does not describe the instant method of coating the composition of claim 1.

Note that the claims are indefinite, as discussed below, and that this rejection is applied to one of the two possible interpretations of the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28, 29 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites a method comprising coating the composition of claim 1. However, claim 1 defines a composition that is used as a coating, not a composition to be coated itself. It is unclear if the claim describes a method of coating some material with the composition of claim 1, or if the claim describes a method of coating the polymer composition of claim 1 with some other material.

Claims 29 and 36 are rejected for depending on claim 28 without clarifying this issue.

### ***Claim Rejections - 35 USC § 102***

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Note that the rejections under this statute are based on the interpretation that the claims read on a material coated by the elected polymer composition.

Claims 28, 29 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by US 6,527,938 to Bales et al.

Bates teaches a method of making a coated stent by mixing a SIBS polymer with an active agent and coating the mixture on a steel or titanium alloy stent (col. 2, lines 23 – 33).

Claims 28, 29, and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by US 6,545,097 to Pinchuk et al., of record (IDS filed 3/22/2006).

Pinchuck discloses a stent coated with SIBS and method of making the same (figure 1 and descriptions thereof, examples). Active agents may be included in the coating (claim 14).

Claims 28, 29, and 30 are rejected under 35 U.S.C. 102(a) as being anticipated by US 6,835,387 to Herrmann.

Herrmann teaches a method of coating stents with a superoxide dismutase mimic (a drug) and SIDS (Example).

### ***Conclusion***


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 1615

  
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